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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,060	06/13/2001	Tadashi Ohashi	1341.1096	4634

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT PAPER NUMBER

2179

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,060

Applicant(s)

OHASHI, TADASHI

Examiner

Joshua D Campbell

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment file on 11/15/2004
2. Claims 1, 3-9, and 11-16 are pending in this case. Claims 1, 8, and 9 are independent claims. Claims 2 and 10 have been cancelled. Claims 1, 3-5, 8, 9, 11-13, and 15 have been amended. Claim 16 has been newly added.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 8, 9-11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Muranaga et al. (hereinafter Muranaga, US Patent Number 5,671,428, issued on September 23, 1997).

Regarding independent claim 1, Muranaga discloses a method in which a document that is to be examined is stored in a document database (Figure 1, item number 4 of Muranaga). Muranaga also discloses a method in which examiners (reviewers or commentators) attributes are also stored in a database (column 20, line 30-column 21 line, 15 of Muranaga). Based on attributes a user may select the examiner(s) (proofreaders) that are to review the document at which point the system requests that the examiner reviews the document (column 3, line 18-column 4, line 21

and column 17, line 25-column 20, line 55 and column 24, line 49-column 25, line 5 of Muranaga). Muranaga also discloses a method in which the examiner may use a browser to view the document and may input results (comments) about the document, at which point the comments may be viewed by the requester, all users may have access to their own personal terminal device connected to a network (column 3, line 18-column 4, line 21 and column 7, line 3 through 40 of Muranaga).

Regarding dependent claim 3, Muranaga discloses a method in which based on the importance/priority of a document only certain examiners may have full access to the document based upon the priority set forth in their own attributes (column 20, lines 30-67 of Muranaga).

Regarding independent claim 8, the claim incorporates substantially similar subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim 1.

Regarding independent claim 9 and dependent claim 11, the claims incorporate substantially similar subject matter as claims 1 and 3. Thus, the claims are rejected along the same rationale as claims 1 and 3.

Regarding independent claim 16, the claim incorporates substantially similar subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim 1.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muranaga et al. (hereinafter Muranaga, US Patent Number 5,671,428, issued on September 23, 1997) as applied to claims 2 and 10 above, and further in view of IBM Technical Disclosure Bulletin (hereinafter IBM, published on March 1, 1994).

Regarding dependent claim 4, Muranaga does not disclose a method in which the status of the result is checked and that reminders are sent to the examiner.

However, IBM discloses a method in which a document reviewer is sent a reminder of a due date prior to the due date if the review is not completed and sent another reminder when the review becomes overdue (Pages 2-3 of IBM). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Muranaga and IBM because it would have increased the ability of work getting done on time.

Regarding dependent claim 12, the claim incorporates substantially similar subject matter as claim 4. Thus, the claim is rejected along the same rationale as claim 4.

7. Claims 5-7 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muranaga et al. (hereinafter Muranaga, US Patent Number 5,671,428, issued on September 23, 1997) as applied to claims 1-2 and 9-10 above, and further in view of Pavlov (US Patent Number 6,725,426, filed March 17, 2000).

Regarding dependent claim 5 and 6, Muranaga discloses a method in which the examination results are stored in a database and summed up (list of all comments) and the user is allowed to browse the results (column 10, line 31-column 11, line 39 of Muranaga). Muranaga does not disclose a method in which an XML tag is attached to every phrase in the results or that the original examination file is converted into an XML file. However, Pavlov discloses a method in which word processing documents are converted into XML files (column 1, line 42-column 2, line 15 of Pavlov). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Muranaga with the method of Pavlov because it would have allowed for device independent document and result sharing.

Regarding dependent claim 7, Muranaga does not disclose a method in which a document that is stored is presented as a model when compiling an examination document. However, Pavlov discloses a method in which style rules (style sheet), grammar rules, and transition rules are used to convert a document from a word processing format to an XML format (column 3, line 48-column 4, line 41 of Pavlov). The rules could be considered to be a model of any document that has already been compiled using the process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Muranaga with

the method of Pavlov because it would have allowed for a uniform style/format of all documents in the system.

Regarding dependent claims 13-15, the claims incorporate substantially similar subject matter as claims 5-7. Thus, the claims are rejected along the same rationale as claims 5-7.

Response to Arguments

8. Applicant's arguments filed 11/15/2004 have been fully considered but they are not persuasive.

Regarding the arguments on pages 6-7, with regards to independent claims 1, 8, and 9, the examiner notes that showing the differences between one embodiment of the prior art in question (Muranaga) is not sufficient to overcome the rejection, particularly when another embodiment of Muranaga's disclosure teaches the limitations in question. As clarified in the rejection, the embodiment disclosed in column 24, line 49-column 5, line 4, which is shown as known embodiment of such an invention in column 1, lines 36-45, teaches the requester selecting a plurality of examiners based on their attributes (column 17, lines 25-40 of Muranaga) at which point the examination is requested and the results (comments) of said examination is collected and displayed to any of the of the allowed users (author and examiners) (column 3, line 18-column 4, line 21 and column 17, line 25-column 20, line 55 and column 24, line 49-column 25, line 5 of Muranaga).

Regarding the arguments on page 7, with regards to dependent claim 3, the examiner notes that the claim is not independently patentable and can not be interpreted independently from the claims it depends on, thus all limitations from the parent claims will be read into the dependent claim in order to determine patentability. As stated in the rejection above, Muranaga has disclosed the limitations of claim 3, which includes the limitations incorporated by the dependency on claim 1. In addition to the limitation of claim 1, discussed in the previous paragraph, Muranaga discloses a method in which a degree of importance is set for a document that controls permission or prohibition of browsing depending on the degree of importance (column 20, lines 30-67 of Muranaga). For instance, as explained by Muranaga, parameters may be set that allow the execution condition that permits only a supervisor of a department (i.e. chief of department) to process a document, the level of importance dictates that the document be processed at a higher level of authority.

Regarding the arguments on pages 7-8, with regards to dependent claims 4 and 12, as stated by the applicant, the IBM Bulletin discloses a scheduling device that reminds reviewers of electronic folders regarding due dates and due time (page 7 of the arguments), which is interpreted to mean that the system urges (reminds) the examination of document to the examiner (reviewer) in charge of that document (folder) if the result has not been collected (not completed) both before it is due and after it is overdue (IBM Bulletin Pages 2-3).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC

February 18, 2005


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